

REMARKS

In the last Office Action, dated October 31, 2006, the Examiner rejected claims 1-36 under 35 U.S.C. § 102(e), as anticipated by U.S. Publication No. 2003/00556688 (hereafter "*Saran*"). Applicants have amended independent claims 1, 5, 9, 13, 17, and 21, as suggested by the Examiner, to more appropriately define the invention. Claims 1-36 are pending, of which claims 1, 5, 9, 13, 17, and 21 are independent. Applicants respectfully traverse the Examiner's rejections and request reconsideration of the application, as amended.

Anticipation under 35 U.S.C. § 102(e) requires that a single prior art U.S. patent describe each and every claimed element, either expressly or inherently. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Applicants respectfully submit that *Saran* is not a valid 102(e) reference because *Saran* does not describe each and every element of the claims, as amended, for at least the reasons stated below.

I. Independent Claims 1, 5, 9, 13, 17, and 21

Saran fails to describe "an availability query ... seeking the availability of the item number ... without modifying the data records," as recited in Applicants' amended independent claims 1, 5, 9, 13, 17, and 21. In the last Office Action, the Examiner agreed that *Saran* is distinguishable from an "availability query [that], unlike an update, does not necessarily require modifying database records," and the Examiner suggested adding this recitation to the claims. (October 31, 2006 Office Action, p. 4, ll. 15-20). Applicants' proposed Amendment incorporates the Examiner's advice by adding a similar recitation to independent claims 1, 5, 9, 13, 17, and 21. Because *Saran*

describes various methods for performing inventory updates, *Saran* does not describe each and every element of the amended claims, as required under 35 U.S.C. § 102(e).

In addition, “anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation.” *Atofina v. Great Lakes Chemical Corp.*, 441 F.3d 991, 1000 (Fed. Cir. 2006). In the last Office Action, the Examiner agreed that “a person scanning physical inventory typically would not use an availability query because that person can see that the scanned inventory is available.” (October 31, 2006 Office Action, p. 4, ll. 15-20.) *Saran* involves scanning physical inventory to update inventory records (p. 7, para. [0093]), and therefore does not “necessarily include” performing an availability query “without modifying the data records,” as claimed by Applicants. Instead, the inventory update described in *Saran* requires modifying the data records. (Id.) Consequently, *Saran* does not inherently describe “an availability query ... seeking the availability of the item number ... without modifying the data records,” as required under 35 U.S.C. § 102(e).

For at least these reasons, *Saran* does not expressly or inherently describe every recitation of independent claims 1, 5, 9, 13, 17, and 21. Therefore, those claims are not anticipated under 35 U.S.C. § 102(e). Because the dependent claims (2-4, 6-8, 10-12, 14-16, 18-20, and 22-36) necessarily include the recitations of the independent claims, the Examiner should allow all pending claims, 1-36.

II. Dependent Claims 25-30

As an additional ground of allowance for dependent claims 25-30, Applicants respectfully submit that *Saran* does not teach that “the displayed result is other than a number,” as recited in those claims. The Examiner points to page 11, para. [0130]-

[0131] of *Saran*, but these passages describe relaying a “re-order” message to third party adapter 540 instead of displaying the result. Because the third party adapter 540 of *Saran* is not the same as the handheld inventory scanner 560, it is unclear how sending a message to third party adapter 540 could possibly result in displaying the message to the user of a mobile device, as recited in claims 25-30. Because *Saran* does not describe all recitations of claims 25-30 as required under 35 U.S.C. § 102(e), claims 25-30 should be allowed over *Saran*.

III. Dependent Claims 31-36

Dependent claims 31-36 also have an alternative basis for allowance. *Saran* does not disclose that “the mobile device receives the item number and quantity from a user not in the physical presence of the item,” as recited in claims 31-36. The Examiner points to paragraphs [0123] and [0124] as evidence of this disclosure, but those passages relate to the barcode-lookup step of an inventory update and do not discuss the use of a mobile device. It is unclear how these teachings describe “a user not in the physical presence of the item,” because barcode scanning necessarily must be done by a user in the physical presence of the item. Therefore, *Saran* does not describe all recitations of claims 31-36 as required under 35 U.S.C. § 102(e).

IV. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-36 in condition for allowance. Applicants submit that the proposed amendments of claims 1-36 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in

the claims as examined. For example, the added recitation "without modifying the data records" is descriptive of a "query," as previously claimed. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

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Respectfully submitted,

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